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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,618	08/07/2001	Fumitake Yodo		1742

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,618	Applicant(s) Fumitake Yodo
	Examiner Andrew J. Fischer	Art Unit 3627
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<p>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</p> <p>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</p> <p>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</p> <p>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</p> <p>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Feb 21, 2003</u> .		
2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>10-12</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>10-12</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received in Application No. <u>09/600,509</u> . 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). *See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
6) <input type="checkbox"/> Other: _____		

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination (“RCE”) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed (Paper No. 10) in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant’s submission filed on January 16, 2003 (Paper No. 7) has been entered.

Acknowledgments

2. According to the RCE noted above, the after final amendment filed January 16, 2003 (Paper No. 7) is acknowledged. Accordingly, claims 11 and 12 remain pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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a. In claim 11, the phrase “updating the accounting points . . . and updating attributes . . . when the distributed information is stored in the second memory of the terminal device” is unclear. First, line 7 of claim 11 states “storing distributed information . . .” Lines 11 and 12 recite “when the distributed information is stored . . .” Therefore, its unclear if the “updating [of] the accounting points” and “updating [of the] attributes” occurs upon the *initial* storing of the “distributed information” as occurs in line 7, or alternatively, the updating occurs when the distributed information is stored.

In other words, it is believed that Applicants intend the “stored” as stated in the beginning of line 12 to be “updated” and not “stored.” Since “attributes” are a subset of the “distributed information,” “updating attributes” can never occur before the “distributed information is stored” making the updating in line 15 unclear and the entire claim unclear.

Moreover, the “when distributed information is stored” in line 13 appears on its face to cover the initial storing of information (as recited in line 7) as well. Therefore updating can never occur until the distributed information is stored at least once making the updating in line 15 unclear. It is not known whether Applicant intends the “when distributed information is stored” in line 13 to be the same or different from the “storing distributed information in line 7. “Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one.”

Interactive Gift Express, Inc. v. CompuServe, Inc., 256 F.3d 1323, 1342, 59 USPQ2d 1401, 1416 (Fed. Cir. 2001).

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b. In claim 12, the phrase "updating the attributes of the distributed information when the distributed information is stored" is unclear. Since attributes are a subset of the distributed information, it is a truism that the attributes will be updated every time they are updated (when the updating is stored).

c. In both claims, it is believed that Applicant does not intend to do the updating when the initial points and information is stored.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 11 and 12, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Peterson, Jr. (U.S. 5,857,020) ("Peterson '020"). Peterson '020 discloses in the alternative embodiment shown in figure 3: a terminal device (86, 98 and 70 all shown in figure 3); storing accounting points in a first memory (at 91); storing distributed information (76, 80-85, 78, 79, 93, and 92) distributed from an external source (inherent); updating the accounting points storing in the first memory of the terminal device and updating attributes (the various attributes

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76, 80-85, 78, 79, 93, and 92) of the distributed information (making the encrypted information available) when the attributes is stored (e.g. when an ID is added to list 92 making the encrypted content available); when the distributed information is stored (when medium 70 is burned, the secured data 79 is in an unavailable state); when the accounting points (the funds) are updated correctly (decremented) based upon the distributed information (the requested access), the secured content is updated to an available state; carrying out account processing in the accounting center (16) based upon the accounting points transmitted from the terminal device (adding more funds to the secured card 88 through the online access to the authorization center, column 2, ~lines 62-66); when the accounting points are not updated correctly (when the system detects that the user doesn't have enough funds); a request is made at the terminal device to the accounting center for purchasing the accounting points (through the online access to the authorization center, column 2, ~lines 62-66); carrying out another account processing (providing a monthly bill to the consumer showing funds added and funds used).

7. Functional recitations using the word "for" (e.g. "for communicating with the accounting center" as recited in claim 11) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression doe not result in a manipulative difference in the steps of the claim.). Where an intended use is not

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desired, the Examiner recommends removing “for” from the claims. For example, instead of “for communicating” the Examiner suggests simply --communicating--.

8. For due process purposes, the Examiner again notes that Applicant has decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustom meanings. The Examiner cites three (3) reasons to support his position. First, after receiving notice of the Examiner’s position that the Examiner believed lexicography was *not* invoked,¹ Applicant elected *not* to point out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b).² Second and also as stated in the First Final Office Action, it is again the Examiner’s factual determination that not only has Applicant failed to point to definitional statements in his specification or prosecution history, Applicant has also failed to point to a term or terms in a claim with which to draw in those statements.³ Finally and also as noted in the First Final Office

¹ See the Office Action mailed April 24, 2002, Paper No. 4, Paragraph No. 7.

² See the Examiner’s final Office Action mailed October 31, 2002, Paper No. 6, Paragraph No. 7 (Hereinafter the “First Final Office Action”).

³ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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Action, Applicant has declined the Examiner's express invitation⁴ to be their own lexicographer.⁵ Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustom meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997),⁶ and the Examiner continues to rely heavily and extensively on this interpretation.⁷ See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) ("Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning . . .") (Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

⁴ See again the Office Action mailed April 24, 2002, Paper No. 4, Paragraph No. 7.

⁵ The Examiner's request on this matter was reasonable on at least two separate and independent grounds: first, the Examiner's request was simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed March 19, 2003).

⁶ See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁷ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . [Emphasis added.]"

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9. Regarding first and second memory locations, it is the Examiner's position that these are inherent in any computation device. Different memory addresses sufficient to hold all the claimed data disclose these limitations.

10. Regarding "carrying out an other accounting processing," it is the Examiner's position that this too is inherent. Under the broadest reasonable interpretation standard discussed above, virtually any account processing would meet this limitation. Only if a system performs a *single* account process (which none of the prior art does since they are *all* directed to multiple processes), would this limitation not be met.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 11 and 12, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over standard accounting practices. The Examiner notes that the standard accounting functions found in claims 10-12 are admitted prior art (see below). It is indeterminate as to whether the computerization of these steps is old and well known.

If not old and well known, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify standard accounting steps and to automate them

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with a computer. Providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish the claimed invention over the prior art in terms of patentability. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 93, 94 (CCPA 1958). See e.g. Brown (U.S. 5,875,423) as evidence that automating and accounting system is old and well known in the art.

13. Again since Applicant did not seasonably traverse the Official Notice statements as stated in the Office Action (Paper No. 4, Paragraph No. 9 mailed April 24, 2002), the Official Notice statements are taken to be admitted prior art. See MPEP §2144.03.

Response to Arguments

14. Applicant's arguments with respect to claims 11 and 12 have been considered but are moot in view of the new ground(s) of rejection.

15. It is noted that "Applicant objects to the statement made in the Office Action at paragraph 13 that 'the standard accounting functions found in claims 10-12 are admitted prior art'." The Examiner noted that the Official Notice statements were admitted prior art because Applicant failed to adequately traverse the Official Notice statements in his next reply.

"A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well know statement in the next reply after the Office action in which the well known statement is made." MPEP §2144.03. In this case, Applicant failed to make a seasonable challenge in his first reply, his reply received July

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23, 2002 (Paper No. 5). The Examiner therefore maintains his position that the Official Notice statements are admitted prior art.

Conclusion

16. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

17. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant disagrees with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁸ the Examiner respectfully requests Applicant *in his next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications,

⁸ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

AJF 3/19/03
ANDREW J. FISCHER
PATENT EXAMINER

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March 19, 2003